

*REMARKS*

*Background for this Response*

Applicants acknowledge, with appreciation, the courtesies extended by Examiner Miller during the course of the telephone conversation with the undersigned attorney on June 22, 2004. During the course of the telephone call, applicants explained their belief that there is no need for applicants to file an RCE or Notice of Appeal because applicants' response is believed to overcome the prior rejections, in light of the previous Rule 131 Declaration, and since the rejections set forth in the Office Action dated January 16, 2004 were improper. The claim amendments made in the April 16 response, and re-submitted here, are voluntary and are not in response to the Office Action of January 16, 2004. Examiner Miller agreed that applicants do not need to file an RCE to have this response considered.

In the Advisory Action dated June 8, 2004, the United States Patent and Trademark Office (the "Office") found applicants' response of April 16, 2004 as non-compliant with Rule 121 (A)(1). This response is believed to cure the deficiency of applicants' April 16, 2004 response, which did not list claims 1-13 and 25-26, which were deleted by way of Preliminary Amendment dated January 26, 2001, which was the filing date of the application inasmuch as this application is a divisional application of U.S. Application 09,506,757. This response lists claims 1-13 and 25-26 and the status thereof. Normally, the Office provides applicants with an opportunity to respond within 30 days of the date of an Action setting forth a non-compliance rejection pursuant to Rule 121 (A)(1). Accordingly, applicants believe that there is no need for any extension fee with this response. However, if applicants are in error in this regard, the Office is authorized to charge Deposit Account No. 12-1216 for the required extension fee, which applicants hereby petition for if needed.

*Summary of the Office Action dated January 16, 2004*

Claims 14-20, 23, 24, and 27-29 stand rejected under 35 U.S.C. § 102(e) as anticipated by Cohen (*i.e.*, U.S. Patent 5,947,672). Claims 21, 22, and 30 stand rejected under 35 U.S.C. § 103(a) as obvious over Cohen alone or in combination with Machlica (*i.e.*, U.S. Patent 5,910,353). The Office argued that, though the declaration under Rule 1.131 submitted by the Applicants was sufficient to demonstrate conception and reduction to practice of the claimed invention, the declaration failed to demonstrate due diligence to the

priority date of the Application, and was, therefore, insufficient to antedate the Cohen reference.

*Summary of Examiner Interview and Discussion of Standing Rejections*

Applicants wish to thank Examiner Miller for the courtesies extended to applicants' attorneys, Salim A. Hasan and Jason T. Murata, in the telephone interviews conducted on February 11, and February 18, 2004. As discussed in the Examiner interviews, applicants believe that the October 29, 2003 submission of the declaration under 37 C.F.R. § 1.131 by Christopher Doerr is sufficient to antedate the Cohen et al. reference. To support their position, applicants pointed to Rule 1.131 and M.P.E.P. § 715.07(a). The Examiner generally agreed with applicants assertions but asked for applicants to submit a request for reconsideration outlining the relevant law.

To this end, in order to antedate a reference, an Applicant may submit a declaration which demonstrates *either* (a) conception and reduction to practice of the claimed invention; *or* (b) conception of the invention and due diligence to the priority date of the application for patent, prior to the filing date of the prior art reference. 37 C.F.R. § 1.131. Only due diligence *before* reduction to practice is a material consideration. M.P.E.P. § 715.07(a). *See also*, Form Paragraph 7.62, Examiner Note 5; *Ex parte Merz*, 75 U.S.P.Q. 296 (Bd. App. 1947) (cited, with authority, in Form Paragraph 7.62, Examiner Note 5). The lapse of time between the completion or reduction to practice of an invention, and the filing of an application thereon are simply irrelevant to an affidavit or declaration under 37 C.F.R. § 1.131.

Applicants note that the Office acknowledged that the declaration filed on October 29, 2003 under 37 C.F.R. § 1.131 "provides evidence of conception of the invention and reduction to practice prior to the filing date of Cohen et al." Office Action, ¶ 7. In view of the foregoing, such a showing is sufficient, under 37 C.F.R. § 1.131, to antedate the Cohen et al. reference, thereby removing the prior art rejections predicated on Cohen et al. As set forth above, demonstration of "due diligence from prior to the filing date of the Cohen reference to the filing of the instant application" (Office Action, ¶ 7) in a declaration under Rule 1.131 is not a required to antedate a prior art reference. M.P.E.P. § 715.07(a).

The Doerr declaration establishes that the claimed subject matter was conceived and reduced to practice before the publication date of Cohen, which has been cited as prior art in rejection claims 14-24 and 27-30 under 35 U.S.C. §§ 102(e) and 103(a). Cohen has a filing date of June 10, 1998, as shown on the face of the patent. Machlica does not disclose a hang tag comprising a first surface, second surface, and a slot defined therebetween, as recited in

the pending claims and therefore does not provide description of a hang tag which can be said to teach or fairly suggest the claimed invention. Since Cohen is not prior art to the invention recited in the pending claims, and since Machlica fails to disclose a hang tag as recited in the pending claims, the rejections under 35 U.S.C. §§ 102(e) and 103(a) are improper and should be withdrawn. Thus, reconsideration of the basis of the rejection set forth in the Office Action is respectfully requested.

### *The Pending Claims*

Claims 14-24 and 27-47 are currently pending and are directed to a hang tag that is capable of automatically and permanently being attached to an elongated object by a machine having at least one jaw suitable for applying a securement strap to an object. The hang tag comprises a first surface, a second surface, and a slot defined therebetween. The slot has minimum dimensions of at least about 0.25 inches by about 1 inch. Significantly, in preferred embodiments, the hang tag can hold a 5 lb weight without slipping from an original position on the elongated object by more than 0.5 inches. Reconsideration of the rejections of the pending claims is respectfully requested.

Referring to specific claim amendments made herein, claims 17-19 have been cancelled, without prejudice, as superfluous in light of claims 27-28 and new claim 48. New claim 48 mirrors the language of original claim 19.

Claim 14 has been amended so as to point out more particularly and claim more distinctly the subject matter of the invention. In particular, the claim has been amended to recite that the hang tag *can hold a 5 lb weight without slipping from an original position on the elongated object by more than 0.5 inches* so as to satisfy the 5 pound test requirement set forth in Underwriters Laboratories (UL) standard 817, as explained in the present specification, which test is known in the art. Support for the amendment can be found at, *e.g.*, page 2, lines 25-31, Example 1 and Comparative Example 1A. Claims 15 and 16 have been amended with respect to their dependency in view of the new claims as discussed below.

Claims 31-47 have been added, depending from claim 14, either directly, or indirectly. Claims 31-32 recite additional properties that the hang tag can have. Support for these properties can be found at, *e.g.*, page 5, lines 8-10, page 17, line 27, to page 18, line 10, and Comparative Example 1A (durable thermoplastics); page 3, lines 21-30, page 15, lines 10-15, and page 20, line 35, to page 21, line 2 (oil suspension test); page 16, lines 24-32, Example 1 and Comparative Example 1A (slot is provided more than about 0.10 inches from each edge); and page 15, lines 28-30, Example 1 (thickness of about 1 mils to about 30 mils).

New claim 33 recites that the slot is provided at least 0.30 inches from each edge. Support for this claim can be found at, *e.g.*, page 17, lines 34-35. Claims 34-36 and 47 recite features that the slot can have. Support for claim 34 can be found at, *e.g.*, claims 17 and 27 as originally filed; support for claim 35 can be found at, *e.g.*, claims 18 and 28 as originally filed; and support for claims 36 and 47 can be found at, *e.g.*, claim 19 as originally filed. Support for claims 34-36 and 47 can also be found at, *e.g.*, page 16, lines 10-13.

Claims 37-40 recite particular materials from which at least a portion of the hang tag can be formed. Support for these claims can be found at, *e.g.*, original claims 20, 21, and 22, and page 16, lines 21-34. Claim 41 recites that the hang tag further comprises a grommet reinforcing the slot. Support for this claim can be found at, *e.g.*, original claim 23 and page 16, lines 13-18. Claims 42 and 43 recite particular thicknesses that the hang tag may have. Support for these claims can be found at, *e.g.*, page 15, lines 28-30. Claims 44-46 recite minimum dimensions that the slot can have. Support for these claims can be found at, *e.g.*, page 16, lines 2-5.

Further, claims 48 and 49 have been added, depending from claims 29 and 30, respectively. These new claims recite that the hang tag in the respective base generic claims can hold a 5 lb weight without slipping from an original position on the elongated object by more than 0.5 inches. Support for the new claims can be found at, *e.g.*, page 2, lines 25-31; Example 1 and Comparative Example 1A.

No new matter has been added by way of these amendments.

The pending claims are believed to be allowable because the prior art of record does not teach or suggest the hang tag as recited in the amended claims.

The Office alleges that Applicants have conceded the rejection of claims 14-24 and 27-30 as stated in the Office Action of January 16, 2004. Applicants have made no admission. Applicants have argued that prior art rejections predicated on Cohen et al. should be removed, in view of the declarations filed on May 6, 2003, and October 29, 2003. As such, Applicants have not acquiesced in those rejections. In fact, by submitting the declarations, Applicants have argued that the rejections were improper. Thus, there was no need to address the references substantively. Further, in view of the arguments in support of withdrawal of the rejections based on Cohen et al. (*see*, Request for Reconsideration), if the rejections are withdrawn, the issue will be moot.

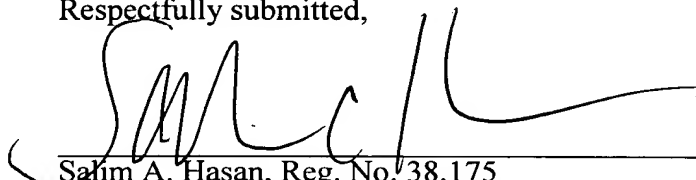
### *Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the

In re Appln. of Doerr et al.  
Application No. 09/771,430

Examiner, a telephone conference would expedite the prosecution of the subject application,  
the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. Hasan', written over a horizontal line.

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